

REMARKS

This Amendment is submitted in response to the Final Office Action dated November 3, 2004. In the Office Action, the Patent Office finally rejected Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek* (U.S. Patent No. 5,697,648) in view of *Schwan et al.* (U.S. Patent No. 5,524,934). Further, the Patent Office finally rejected Claims 16-20 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek* (U.S. Patent No. 5,697,648) in view of *Walz* (U.S. Patent No. 5,664,725).

By the present Amendment, Applicant amended Claims 1, 9, 13 and 16. Applicant submits that the amendments to the application and the reasons that follow overcome the rejections by the Patent Office and place the application in condition for allowance. Notice to that effect is respectfully requested.

With respect to the rejection of Claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over *Petkovsek* in view of *Schwan et al.*, Applicant submits that the amendments to Claims 1 and 13 overcome the rejection under 35 U.S.C. §103(a) and place the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office asserts that *Petkovsek* discloses each of the elements set forth in independent Claims 1 and 13 and the Patent Office alleges that it would have been obvious to place the identifying number and tracking area in

any desirable position on the label of the present invention. Further, with regard to Claims 1, 7, 9, and 13, the Patent Office alleges that Petkovsek's label is capable of denoting special delivery services, including registered mail, certified mail, COD, and return receipt for merchandise. The Patent Office further alleges that the bar coded area of Petkovsek is capable of receiving instructions regarding the delivery of the mailpiece by a special service, as in Claim 13. Moreover, the Patent Office alleges that the steps of Claims 13-15 define a method that is taught by Petkovsek.

Independent Claim 1, as amended, defines a special service mailing assembly that requires a first mailing form that has a first return postcard, a first designator section and a first receipt section. The first receipt section denotes one of a plurality of types of special delivery services and a cost for delivery by the one of the plurality of types of special delivery services. Further, the first designator section has a first area that receives variably printed information. Moreover, independent Claim 1, as amended, requires a second mailing form removably attached to the first mailing form that includes a second receipt section having cost information, a second return postcard and a second designator section. The second designator section has a second area that receives variably printed information.

Independent Claim 13, as amended, defines a method for preparing a mailpiece for delivery by a special delivery service having the step of providing a first mailing form that includes a first return postcard integrally formed with a first special service designation section and a first receipt section. The first receipt section denotes the special delivery service and a cost for delivery by the special delivery service. Further, the first special service designation section has a first area for receiving instructions regarding the delivery and for denoting the special delivery service. Moreover, independent Claim 13, as amended, requires the step of providing a second area within the first return postcard wherein variable information is printed.

Further, independent Claim 13, as amended, requires the step of providing a second mailing form that has a second return postcard integrally formed with a second receipt section and a second special designation section. The second receipt section denotes the special delivery service and a cost for delivery by the special delivery service. Independent Claim 13, as amended, also requires the step of printing information relating to the special delivery service on a first area within the second return postcard.

Contrary to the assertion of the Patent Office, *Petkovsek* merely teaches an integral special service mailing assembly for mailing an article requiring special services which has a return receipt postcard and a label indicative of the special service

and a method for using the same. More specifically, *Petkovsek* merely teaches an assembly that is "formed from a single sheet 11 to provide both a label 12 and a return postcard 13" wherein "[t]he return receipt postcard 13 may include a set of instructions 20 for the sender, as well as an article addressee section 22 for pre-printing the addressee's address."

Moreover, *Petkovsek* merely teaches a method of providing a first sheet attached to a second sheet that has a first section including a label and a second section including a form with first and second anchor sections. *Petkovsek* merely teaches a return receipt postcard having a set of instructions for the sender, an addressee section and a document control number bar code.

*Schwan et al.* merely teach a business record in which different selected areas may be activated to form colored areas. The color formers and color developers combine upon exposure of an imaging force, such as heat or pressure, to form visible areas.

Clearly, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest a first mailing form that has a first return postcard, a first designator section and a first receipt section, which denotes one of a plurality of types of special delivery services and a cost for delivery by the one of the plurality of types of special delivery services, as required by independent Claim 1, as amended. Further, neither *Petkovsek*

nor *Schwan et al.*, taken singly or in combination, teach or suggest that the first designator section has a first area that receives variably printed information, as required by independent Claim 1, as amended.

Moreover, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest a second mailing form removably attached to the first mailing form that includes a second receipt section having cost information, a second return postcard and a second designator section, as required by independent Claim 1, as amended. Further, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest that the second designator section has a second area that receives variably printed information, as required by independent Claim 1, as amended.

Still further, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of providing a first mailing form that includes a first return postcard integrally formed with a first special service designation section and a first receipt section denoting the special delivery service and a cost for delivery by the special delivery service, as required by independent Claim 13, as amended. Further, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest the first special service designation section having a first area for receiving instructions regarding the delivery and for denoting the special

delivery service, as required by independent Claim 13, as amended. Still further, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of providing a second mailing form that has a second return postcard integrally formed with a second receipt section and a second special designation section, wherein the second receipt section denotes the special delivery service and a cost for delivery by the special delivery service, as required by independent Claim 13, as amended. Moreover, neither *Petkovsek* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of printing information relating to the special delivery service on a first area within the second return postcard, as required by independent Claim 13, as amended.

With respect to the rejection of Claims 1 and 13 under 35 U.S.C. §103(a), one of ordinary skill in the art would never have been motivated to modify *Petkovsek* with *Schwan et al.* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is

whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's mailing assembly and method, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Petkovsek* and *Schwan et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Petkovsek* with *Schwan et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

In view of the foregoing, the rejection of Claims 1-15 under 35 U.S.C. §103, in view of *Petkovsek* and further in view of *Schwan et al.* has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 16-20 under U.S.C. §103(a) as being unpatentable over *Petkovsek* in view of *Walz*, Applicant submits that the amendment to Claim 16 overcomes the

rejection and places the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office alleges:

Petkovsek discloses in Fig. 1, 2 and 6... a first return postcard (13) integrally formed with a designator section... indicative of a special service of registered mail, COD, or return receipt (Col. 4, lines 10-14 and 29-31) having an area consisting of a machine readable code (24 for tracking the mailpiece), an identifying number (26A), an area for receiving instructions (20) that is juxtaposed to the designator section and contained within the first exterior sides (right of perforated line 29a, and left of perforated line 33a) that defines the postcard.

Independent Claim 16, as amended defines a mailing assembly for preparing a mailpiece for delivery by a special service having a first mailing form with a first receipt section, a first return postcard and a first anchor portion. The first receipt section denotes the special service and a cost for delivery by the special service. Further, independent Claim 16, as amended, requires a second mailing form having a second receipt section, a second return postcard and a second anchor portion. The second receipt section denotes the special service and a cost for delivery by the special service. Still further, independent Claim 16, as amended, requires a first designator section indicative of a type of special mail delivery service and printed with variable information that identifies a type of the special mail delivery service.

Contrary to the assertion of the Patent Office, Petkovsek merely teaches an integral special service mailing assembly for mailing an article requiring special services which has a return



receipt postcard and a label indicative of the special service and a method for using the same. More specifically, *Petkovsek* merely teaches an assembly that is "formed from a single sheet 11 to provide both a label 12 and a return postcard 13" wherein "[t]he return receipt postcard 13 may include a set of instructions 20 for the sender, as well as an article addressee section 22 for pre-printing the addressee's address."

Moreover, *Petkovsek* merely teaches a method of providing a first sheet attached to a second sheet that has a first section including a label and a second section including a form with first and second anchor sections. *Petkovsek* merely teaches a return receipt postcard having a set of instructions for the sender, an addressee section and a document control number bar code.

Contrary to the assertions of the Patent Office, *Walz* merely teaches a multi-part mailing form for use by businesses in mailing items to various customers or clients and in keeping records of such mailings and is particularly related to forms for use in certain specific types of mailing, such as certified and registered mail procedures.

Neither *Petkovsek* nor *Walz*, taken singly or in combination, teach or suggest a first mailing form with a first receipt section, a first return postcard and a first anchor portion, wherein the first receipt section denotes the special service and a cost for delivery by the special service, as required by independent Claim 16, as amended. Further, neither *Petkovsek* nor

Walz, taken singly or in combination, teach or suggest a second mailing form having a second receipt section, a second return postcard and a second anchor portion, wherein the second receipt section denotes the special service and a cost for delivery by the special service, as required by independent Claim 16, as amended. Still further, neither Petkovsek nor Walz, taken singly or in combination, teach or suggest a first designator section indicative of a type of special mail delivery service and printed with variable information that identifies a type of the special mail delivery service, as required by independent Claim 16, as amended.

Moreover, with respect to the rejection of Claims 16-20 under 35 U.S.C. §103(a), one of ordinary skill in the art would never have been motivated to modify Petkovsek with Walz in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of

ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's mailing assembly, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Petkovsek* and *Walz* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Petkovsek* with *Walz* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Accordingly, the rejection of Claims 16-20 under 35 U.S.C. §103(a) as obvious over *Petkovsek* in view of *Walz* has been overcome and should be withdrawn. Notice to that effect is requested.

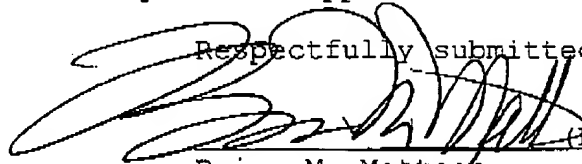
Claims 2-12 depend from independent Claim 1; Claims 14 and 15 depend from independent Claim 13; and Claims 17-20 depend from independent Claim 16. These claims are further believed allowable over the references of record for the same reasons set forth above with respect to their parent claims since each sets forth

additional structural elements and novel steps of Applicant's mailing assembly and method, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment; therefore, entry of this Amendment is proper and should be effected.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

  
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